



Attorney Docket: RP9-99-0051250P

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Joseph A. Sawyer, Jr.
Joseph A. Sawyer, Jr.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

#9
TLR
2/6/02

In Re Application of:

Date: December 3, 2001

Cromer, et al.

Serial No. 09/282,893

Group Art Unit: 2682

Filed: March 31, 1999

Examiner: Banks-Harold, M.

For: METHOD AND SYSTEM FOR PROVIDING PROTECTION AGAINST
THEFT AND LOSS OF A PORTABLE COMPUTER SYSTEM

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Assistant Commissioner of Patents
Washington, D.C. 20231

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APPEAL BRIEF TRANSMITTAL LETTER

Sir:

Submitted herewith are an original and two copies of Appellant's Brief on Appeal which is submitted under 37 C.F.R. 1.192 in connection with the above-identified Patent application. The Brief includes an Appendix.

Please charge the Appeal Brief filing fee of \$ 320.00 to Deposit Account No. 50-0563 (IBM Corporation). A duplicate copy of this paper is attached.

Very truly yours,

Adjustment date: 02/01/2002 HGBREM1
01/28/2002 HGBREM1 00000191 500563 09282893
01 FC:119 320.00 CR

Joseph A. Sawyer
Joseph A. Sawyer
Attorney for Applicants
Reg. No. 30,801
(650) 493-4540



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APPELLANT'S BRIEF

Joseph A. Sawyer, Jr.
Attorney for Appellants
INTERNATIONAL BUSINESS MACHINES
Sawyer Law Group LLP



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02/01/2002 MGE BREM1 00000147 500563 09282893

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APPELLANT'S BRIEF ON APPEAL

Sir:

Appellant herein files an Appeal Brief drafted in accordance with the provisions of 37

C.F.R. § 1.192(c) as follows:

I. REAL PARTY IN INTEREST

Appellant respectfully submits that the above-captioned application is assigned, in its entirety to International Business Machines Corporation, Armonk, New York.

II. RELATED APPEALS AND INTERFERENCES

Appellant states that, upon information and belief, he is not aware of any co-pending appeal or interference which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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III. STATUS OF CLAIMS

Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, and 17 are pending. Application Serial No. 09/282,893 (the instant application) as originally filed included claims 1-17. Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, and 17 are on appeal and all applied prospective rejections concerning Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, and 17 are being appealed herein.

IV. STATUS OF AMENDMENT

The remarks were entered in Advisory Actions dated 8/28/01.

V. SUMMARY OF THE INVENTION

The present invention provides system and method aspects for providing protection against theft and loss of a portable computer system. The present invention includes establishing boundary conditions within which the portable computer system is authorized for use and tracking a position of the portable computer system with a global position system (GPS) unit in the portable computer system. The position is compared to the boundary conditions to identify whether the portable computer system has violated the boundary conditions, and anti-theft routines are performed when the position has violated the boundary conditions. The anti-theft routines include calling a preset phone number with a cellular calling facility of the portable computer system.

Through the present invention, improved security for portable computer systems is achieved. The present invention provides efficient and effective mechanisms for locating and recovering a lost/stolen portable computer system.

VI. ISSUES

The issues presented are:

- (1) whether claims 1, 5-7, 11, 13, and 15-17 are unpatentable under 35 U.S.C. § 102(e); and
- (2) whether claims 2-4, 8-10, 12, and 14 are unpatentable under 35 U.S.C. § 103(a).

VII. GROUPING OF CLAIMS

Appellant hereby states that Claims 1-17 form one group.

VIII. ARGUMENTS

A. Summary of the Applied Rejections

The final office action maintained the rejection of claims 1, 5-7, 11, 13, and 15-17 under 35 U.S.C. 102(e) as being anticipated by D'Amico et al. Appellant respectfully points out that the cited patent is actually the D'Angelo et al. patent, hereinafter referred to as D'Angelo. Claims 2-4, 8-9, and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over D'Angelo in view of Klein. Claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over D'Angelo in view of Klein and further in view of Fleming et al., hereinafter referred to as Fleming. And, Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over D'Angelo in view of well known prior art. In making the rejections, the Examiner argues that D'Angelo discloses everything as claimed, except D'Angelo fails to specifically disclose having the cellular transceiver call a predetermined telephone number (for which the Examiner relies on Klein), and that D'Angelo and Klein fail to disclose using a facsimile protocol to convey location information (for which the Examiner relies on Fleming.) Further, the Examiner has responded to Appellant's previous remarks to these rejections by stating:

Regarding applicant's arguments concerning the GPS system, the examiner respectively disagrees since, based on the substitution or addition, FIG. 2 provides for the flow control to continue the boundary determining process prior to as well as after the alarm is sounded. Therefore, the examiner maintains that the claimed limitations have been addressed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., single unit) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

Appellant respectfully requests that the Board reverse the Examiner's final rejection of Claims 1, 5-7, 11, 13, and 15-17 under 35 U.S.C. § 102(e), and Claims 2-4, 8-9, and 14 under 35 U.S.C. § 103(a).

B. The Cited Prior Art

D'Angelo teaches a motion sensitive theft detector system for portable articles featuring a two-way communication between the theft detector unit installed in or affixed to the portable article and the control unit carried by the owner. The theft detector communicates alerts to the control unit allowing the user to screen for false alarms and to trigger an alarm at the portable article when warranted. A second alarm function selected by the mode switch sounds an alarm automatically in response to motion according to an adaptive alarm sequence. The adaptive alarm varies the alarm in response to frequency and duration of motion so that isolated movement triggers a warning but persistent motion triggers a full scale alarm.

Klein provides a system for generating an alarm in a portable computer system. In one embodiment, when an owner of a portable computer system determines that the portable computer system is either stolen or missing, the owner activates a remote transmitter. This remote transmitter sends an activation signal to a receiver in the portable computer system. In response to the activation signal, the portable computer system takes at least one theft deterrence action, such as generating an audio alarm. Alternatively, the theft deterrence action includes erasing at least part of the contents of a data storage device in the portable computer system. In

another embodiment, the theft deterrence action includes disabling power for the portable computer system. In yet another embodiment, the theft deterrence action includes dialing a telephone number through a mobile telephone coupled with the portable computer system.

Fleming discloses a method for locating an electronic device capable of sending e-mail. The method includes identifying that an e-mail is being sent from the electronic device. Next, the sender address is compared to an owner address. If the sender address does not match the owner address, the e-mail is redirected. In some embodiments, the method is performed by a computer. In other embodiments, the method is performed by a modem.

C. Claims 1, 5-7, 11, 13, and 15-17 Are Not Unpatentable Under 35 U.S.C. § 102(e); and Claims 2-4, 8-10, 12 and 14 Are Not Unpatentable Under 35 U.S.C. § 103(a)

In the present invention, theft protection for a portable computer system is provided. Within the portable computer system, a GPS (global position system) unit tracks the position of the portable computer system. Boundary conditions that are established within the portable computer system are compared in the portable computer system with the position tracked by the GPS unit. Anti-theft routines are performed within the portable computer system when the position tracked has violated the boundary conditions. See independent claim 1. The present invention further includes utilizing cellular calling functionality within the portable computer system to report a potential theft when the boundary conditions have been violated. See independent claim 6. A communication control system that includes a controller, a GPS unit, and a storage unit provides built-in anti-theft capabilities in a portable computer system. See independent claim 13. Appellant respectfully submits that the cited art fails to teach, show, or suggest Appellant's invention. In making the rejections, the Examiner argues that D'Angelo discloses everything as claimed, except D'Angelo fails to specifically disclose having the cellular transceiver call a predetermined telephone number (for which the Examiner relies on Klein), and

that D'Angelo and Klein fail to disclose using a facsimile protocol to convey location information (for which the Examiner relies on Fleming). Appellant respectfully disagrees with the rejections.

The D'Angelo reference discloses the use of a motion sensitive theft detector system for portable articles featuring two-way communication between a theft detector unit installed in or affixed to the portable article and a control unit carried by the owner. As such, the D'Angelo reference clearly utilizes two separately located units to monitor movement and/or proximity of the two units relative to one another when detecting a potential theft. In direct contrast, the present invention performs theft detection entirely within a single unit - the portable computer system itself. Appellant respectfully submits that ability to perform theft detection entirely within a portable computer system is recited in the present invention, particularly in independent claim 13, reproduced herein for the Examiner's convenience:

13. A communication control system for providing built-in anti-theft capabilities in a portable computer system, the communication control system comprising:

a controller;

a GPS (global position system) unit coupled to the controller for tracking a position of the portable computer system; and

a storage unit, the storage unit coupled to the controller and storing preset boundary conditions and out-of-boundary actions, wherein the controller compares the position to the boundary conditions and initiates the out-of-boundary actions when the comparison identifies a violation of the boundary conditions.

Appellant fails to see how the use of two separate units (control unit and theft detector unit) in D'Angelo can teach, show, or suggest performance of built-in theft detection entirely within a portable computer system.

Additionally, the Examiner contends that D'Angelo teaches a GPS unit for tracking a position of the portable computer system at col. 19, lines 49-52. In this cited section, however, D'Angelo makes a blanket statement that its described system "in substitution or addition to sounding the alarm, can ... connect to a GPS system." By disclosing that the connection to a GPS system would occur in substitution or addition to sounding the alarm, D'Angelo teaches the connection to a GPS system only after an alarm is necessary. There is nothing to teach or suggest connection to a GPS system for determining whether an alarm is sounded, i.e., in determining whether a theft may have occurred or in tracking a position of a system with a GPS unit in order to determine whether boundary conditions for the system have been violated. Again, Appellant respectfully submits that the sounding of an alarm (step 68) in D'Angelo (Fig. 2) occurs after a detection of unauthorized movement (step 56). Whether or not the flow control in D'Angelo continues after the sounding of the alarm, the performance of the sounding of the alarm will only occur after the detection of unauthorized movement. There is nothing in D'Angelo's detection that teaches or suggested utilizing a GPS unit to perform the detection of unauthorized movement, as in Appellant's recited invention, which relies on GPS tracking to determine whether a theft has occurred before the performance of anti-theft routines commence.

Further, given the proximity determinations being done in D'Angelo as part of the detection of unauthorized movement, Appellant respectfully submits that the utilization of a GPS unit would not be feasible for such determinations in the D'Angelo reference. As taught by D'Angelo, strength of a signal sent between the control unit and theft detector is used to determine whether a near field proximity of, for example, approximately 15 feet in radius, is maintained (see col. 8, lines 54-61.) Appellant respectfully submits that one of skill in the art would not attempt to utilize a GPS unit to perform proximity determinations in such a narrow distance field.

In view of the foregoing, Appellant respectfully submits that D'Angelo wholly fails to teach, show, or suggest Appellant's recited invention. Further, given the deficiencies of D'Angelo, Appellant respectfully submits that even the inclusion of Klein or Klein and Fleming or the well known prior art, as set forth in the rejections, does not result in any teaching or suggestion of the recited invention. Accordingly, Appellant respectfully requests withdrawal of the rejections under 35 U.S.C. 102(e) and 103.

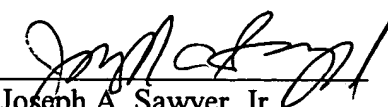
D. Summary of Arguments

For all the foregoing reasons, it is respectfully submitted that Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, and 17 (all the Claims presently in the application) are patentable for defining subject matter which would not have been unpatentable under 35 U.S.C. § 102(e) or 103(a) at the time the subject matter was invented. Thus, Appellant respectfully requests that the Board reverse the rejection of all the appealed Claims and find each of these Claims allowable.

Note: For convenience of detachment without disturbing the integrity of the remainder of pages of this Appeal Brief, Appellant's "APPENDIX" section is contained on separate sheets following the signatory portion of this Appeal Brief.

This Brief is being submitted in triplicate, and authorization for payment of the required Brief fee is contained in the cover letter for this Brief. Please charge any fee that may be necessary for the continued pendency of this application to Deposit Account No.

Very truly yours,


Joseph A. Sawyer, Jr.
Attorney for Appellants
Reg. No. 30,801
(650) 493-4540

IX. APPENDIX

1. A method for providing protection against theft and loss of a portable computer system, the method comprising:

establishing boundary conditions within which the portable computer system is authorized for use;

tracking a position of the portable computer system with a global position system (GPS) unit in the portable computer system;

comparing the position to the boundary conditions to identify whether the portable computer system has violated the boundary conditions; and

performing anti-theft routines when the position has violated the boundary conditions.

2. The method of claim 1 wherein performing anti-theft routines further comprises calling a preset phone number with a cellular calling facility of the portable computer system.

3. The method of claim 1 wherein performing anti-theft routines further comprises prompting a user for a password, wherein when the password matches a master password, operation of the portable computer system continues uninterrupted.

4. The method of claim 3 wherein when the password does not match the master password, operation of the portable computer system is disabled.

5. The method of claim 1 wherein tracking further comprises reporting the position of the portable computer system at preset intervals.

6. A method for providing protection against theft and loss of a portable computer system, the method comprising:

utilizing GPS (global position system) functionality within a portable computer system to track a position of the portable computer system;

identifying when the position tracked by the GPS functionality violates preset boundary conditions of the portable computer system; and

utilizing cellular calling functionality within the portable computer system to report a potential theft of the portable computer system when the preset boundary conditions have been violated.

7. The method of claim 6 further comprising establishing the preset boundary conditions as a chosen distance from a given location within which use of the portable computer system is allowed.

8. The method of claim 6 wherein the step of utilizing cellular calling functionality further comprises calling a preset emergency phone number.

9. The method of claim 8 wherein the step of utilizing further comprises sending a location of the portable computer system to the preset emergency phone number.

10. The method of claim 9 wherein sending further comprises sending the location as a data stream using facsimile protocol.

11. The method of claim 6 further comprising utilizing the GPS functionality at regularly scheduled predetermined intervals.

12. The method of claim 6 further comprising utilizing the GPS functionality during booting upon power-up of the portable computer system.

13. A communication control system for providing built-in anti-theft capabilities in a portable computer system, the communication control system comprising:

a controller;

a GPS (global position system) unit coupled to the controller for tracking a position of the portable computer system; and

a storage unit, the storage unit coupled to the controller and storing preset boundary conditions and out-of-boundary actions, wherein the controller compares the position to the boundary conditions and initiates the out-of-boundary actions when the comparison identifies a violation of the boundary conditions.

14. The system of claim 13 further comprising cellular unit for calling a preset phone number as an out-of-boundary action.

15. The system of claim 14 wherein the cellular unit further reports a location of the portable computer system.

16. The system of claim 13 wherein the GPS unit tracks the position at preset intervals.
17. The system of claim 13 wherein the storage unit stores a predetermined distance from a central location as an in-bounds condition for the portable computer system.